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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,739	03/18/2004	Bao Tran	AFL-016	8291
31688	7590	06/11/2009		
TRAN & ASSOCIATES 6768 MEADOW VISTA CT. SAN JOSE, CA 95135			EXAMINER SKINNER, SHEWANA D	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 06/11/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,739

**Applicant(s)**

TRAN, BAO

**Examiner**

SHEWANA SKINNER

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### DETAILED ACTION

This communication is a Final Action on the merits in response to Applicant's submission received February 12, 2009. **Claims 1, 14 22 and 23** have been amended, subsequently **Claims 1-24** are pending are currently pending and have been considered below.

#### *Response to Amendment*

1. The 35 USC §102 rejection of claim 22-24 is not withdrawn in light of applicant's amendment.
2. The 35 USC §103 rejection of claims 1-6, 8-9 and 17 is not withdrawn in light of applicant's amendment. Examiner maintains rejection with *Lundberg* in view of *PAIR*. In addition, the "generating a docket entry with a deadline" limitation applicant makes note of is not claimed.
3. The amendment filed February 12, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 1, 22 and 23 "without operator intervention".

Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

I. The 35 USC §102 rejection of Claims 19-20 are not withdrawn in light of applicant's argument. Applicant fails to define what "freedom to operate" is and how it is to be determined therefore, Examiner reasoned it to be disclosures.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 22 and 23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "without operator intervention" was not disclosed in the original specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 19-20** are rejected under 35 U.S.C. 102(b) as being anticipated by *Grainger (US 2002/0161733)*, hereinafter, “*Grainger I*”.

*Grainger I* discloses the following as claimed:

**As per Claims 19-20**, *Grainger I* discloses searching one or more databases for one or more relevant IPs (*Grainger I para 96 and 97*); performing a network analysis on the relevant IPs (*Grainger I para 96 and 97*); and determining IPs required to provide freedom to operate (*Grainger I para 96 and 97*) acquiring the least number of IPs to provide freedom to operate (*Grainger I para 96 and 97*).

2. **Claims 22-24** are rejected under 35 U.S.C. 102(b) as being anticipated by *PAIR: Patent Application and Information Retrieval, Press Release (1999)*, hereinafter, “*PAIR*”.

*PAIR* discloses the following as claimed:

**As per Claims 22-24**, *PAIR* discloses receiving an assignee name in lieu of a patent number, published application number or application serial number (*PAIR Press Release where applicant is assignee and assignee name functions the same as customer number*); retrieving copies of all patents and published patent applications matching the assignee name (*PAIR Press Release where assignee name functions that same as customer number*); receiving an application serial number conforming to a format aa/bbbbbb (*PAIR, Use of System - Accessing Issued Patents*); retrieving a published patent application matching the bbbbbb (*PAIR: Objectives*); and generating a single electronic document having all pages of the patent application consolidated therein (*Pair: Objectives*) wherein the retrieving locates a plurality of matching patent

applications, further comprising selecting the patent application whose Series Code matches aa (*Pair: Objectives*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-6, 8, 9 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lundberg* (7,142,713), in view of, *PAIR: Patent Application and Information Retrieval, Press Release* (1999), hereinafter, “*PAIR*”.

**As per Claims 1, 5, 6, and 8** *Lundberg* discloses a patent docketing system that receives electronic patent application information from patent office (*para 2 line 19-20*), having single entries with images consolidated therein (*para 3 line 11-12*), in file wrapped PDF form (*para 3 lines 21-22*) with mailroom dates and document descriptions (*para 2 lines 18-31 and para 4 lines 37-38*), having searchable text (*para 3 lines 21-25*) and annotation (*para 4 line 23 where tagging is an example of annotating capabilities*).

However, it does not explicitly disclose authenticating the user with the patent office computer as referenced in claim 1.

*PAIR* discloses the method of authenticating the user with the patent office computer and downloading the images and file history (*PAIR: Accessing Pending and Abandoned Applications*).

Therefore, it would be obvious to one of ordinary skill in the art to at the time of the invention to retrieve patent application from the patent office, as disclosed in *Lundberg*, through the use of the *PAIR* authentication system because that was the system utilized by the patent office at the time of the invention.

**As per Claims 2, 3, and 17** *Lundberg* discloses in file wrapped PDF form (*para 3 lines 21-22*). having searchable text (*para 3 lines 21-25*) and annotation (*para 4 line 23 where tagging is an example of annotating capabilities*).

**As per Claim 4 and 9**, *Lundberg* discloses having single entries with images consolidated therein (*para 3 line 11-12*), with mailroom dates and document descriptions (*para 2 lines 18-31 and para 4 lines 37-38*).

2. **Claims 7, 10, 16, 18 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lundberg*, in view of, *PAIR*, in further view of *Grainger* (2002/0161733), hereinafter, "*Grainger I*".

**As per Claims 7, 10 and 16** *Lundberg*, in view of *PAIR*, discloses a method of retrieving electronic patent application from the patent office computer in, per Claim 1 where the documents have mail-room dates and document descriptions (*Lundberg para 2 lines 18-31 and para 4 lines 37-38*). However, it does not disclose periodically updating the folder content, including docket entries for documents like responses to office action and displaying the document in tri-fold format.

*Grainger I* discloses a patent application docketing system where the document folders are periodically updated (*para 58 where Case Data Unit is "updated with electronic documents"*),

including docket entries for documents like responses to office action (*para 58*) and the information and displaying the document in tri-fold format (*para 116*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to retrieve electronic patent application documents with system in *Lundberg*, through the use of the *PAIR* authentication system and update those folders *Grainger1* in order to provide current documentation on all patent applications folders in an efficient and visually effective manner.

**As per Claim 18 and 21** *Lundberg*, in view of *PAIR*, discloses a method of retrieving electronic patent applications from the patent office computer with all images therein, per claim 1. However, it does not disclose the searching steps referenced in Claims 18 and 21.

*Grainger1* disclose a patent docketing system that searches databases for relevant intellectual properties (*para 96 and 97*) performing an analysis (*para 96 and 97*) on the IPs found.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the docketing system disclosed in *Lundberg* to utilize the *PAIR* authentication system to retrieve documents and then search for IPs relevant to patent application through the use of the searching methods in *Grainger1* in order to provide an effective search analysis.

3. **Claims 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lundberg*, in view of, *PAIR*, per claim 1, in further view of *Grainger* (US 2002/0059076), hereinafter, "*Grainger2*".



**As per Claims 12-15, *Lundberg***, in view of *PAIR*, discloses a method of retrieving electronic patent applications from the patent office computer that are docketed to assigned persons for prosecution. However, it does not explicitly disclose the process steps referenced in Claims 12-15.

*Grainger2* discloses generating a docketing message to a recipient (*para 160*) indicate the degree of urgency of the docketing message (*para 166 where the types of dates are codes indicating urgency*) automatically generating and automatically docketing electronic documents with the patent office computer (*para 111*) and would have the inherent capability of accommodating various types of electronic documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the docketing system disclosed in *Lundberg* to utilize the *PAIR* authentication system to retrieve documents from the patent office and then use the docketing message and return system employed in *Grainger2* to produce an expedient flow of patent prosecution.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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